

## REMARKS

Claims 1, 3-13, and 15-23 are pending in the present application. By this amendment, claims 1, 6, and 21-23 have been amended, claims 24-29 have been added, and claims 5, 7-8, and 12-20 have been canceled. Accordingly, claims 1, 3, 4, 6, 9-11, and 24-29 are currently under consideration. Applicants respectfully submit that these claims under consideration are allowable

### Amendments to the specification and the figures

Figures 6-7 have been amended to include reference numbers and the specification has been correspondingly amended to describe these figures. The original specification briefly described these figures as illustrative of the present invention on page 5, lines 14-17. The original specification also indicated on page 9, lines 6-7, that the subsequent “general description of the Business Model and its objectives” was made with reference to Figures 6-7. No new matter has been added. “[I]nformation contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” (MPEP 2163.06)

### Claim Objections

According to the Office Action, various claims would be objected to as substantial duplicates under 37 CFR § 1.75 if all claims were allowed. Accordingly, Applicant has cancelled claims 5, 7-8, and 12-20 without prejudice. However, Applicant respectfully submits that claims 9 and 10 are not substantial duplicates. For example, claim 9 includes limitations for “*a first server mechanism*”, “*a second server mechanism*” and “*a third server mechanism*”, while claim 10 includes a limitation for “*a server computer*.”

Applicant respectfully requests that the above-cited objection be withdrawn.

### Claim Rejections Under 35 USC § 112

Claims 1, 5, 6, 9, 10, 12, 13, 17, 18, 20 and 21-23 stand rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the enablement requirement. According to the Office Action, “the applicant only had general statements regarding these financial incentives addressed on pages 11 and 12 of the specification, which describes a generic business model incorporating fee sharing.”

Applicant respectfully traverses this rejection as applied to the claims currently under consideration.

The Examiner has the burden to show a lack of enablement (MPEP 2164.04) This requires analysis of factors related to “undue experimentation”, where “[i]t is improper to conclude that a disclosure is not enabling based on an analysis of only one the above factors while ignoring one or more of the others.” (MPEP 2164.01(a)) With respect to the above-cited rejection, this burden has not been satisfied. In the present application, the specification and figures have been amended to clarify the description of the disclosed embodiments. The portions of the specification cited by the Examiner specifically relate to the disclosed embodiments. Operations associated with the reserve fund are illustrated in Figure 5 and further described in the specification (e.g., page 9, lines 1-5; p 13, lines 9-30). Applicant submits that the description “is sufficient to permit those skilled in the art to make and use the invention.” (MPEP 2164) “Pictures may constitute an enabling disclosure.” (MPEP 2121.04)

Applicant respectfully requests that the above-cited rejection be withdrawn.

Claims 1, 5, 6, 9, 10, 12, 13, 17, 18, 20 and 21-23 stand rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement. According to the Office Action, there is insufficient support for “sending a second portion of the payment funds to a reserve fund and sending a provider payment from the reserve fund to the services provider.”

Applicant respectfully traverses this rejection as applied to the claims currently under consideration.

The Examiner has the burden to show insufficiency of the written description. “A written description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.” (MPEP 2163.04) With respect to the above-cited rejection, this burden has not been satisfied. Relevant aspects of the present invention are illustrated in Figure 5 and described in the original specification (e.g., at page 8, line 20, to page 9, line 5). In particular for the embodiment shown in Figure 5, “*sending a second portion of the payment funds to a reserve fund*” is illustrated at box 535 and “*sending a provider payment from the reserve fund to the services provider*” is illustrated at box 537. Further, it is noted that these portions are determined according to the “business model” (page 9, lines 1-5), options for which are further disclosed elsewhere in the specification (page 13, lines 9-30). Applicant submits that a person skilled in the art would recognize in the disclosure “a description of the invention defined by the claims.” (MPEP 2163.04)

Applicant respectfully requests that the above-cited rejection be withdrawn.

#### Claim Rejections Under 35 USC § 103

Claims 1-3, 5-7, 9-15 and 17-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over “NIC Launches Industry’s First Comprehensive Suite of eGovernment Solutions For Citizens, Businesses and Government”; PR Newswire, New York, June 1, 2000 (hereafter referred to as NIC I) and NICUSA web pages captured via the WayBackMachine (hereafter referred to as NIC II) in view of “For State of Washington AMS’ Buy Plan Made lots of Sense State of Washington awards two-year e-procurement solution contract to American Management Systems”; Washington Technology, page 40+, July 3, 2000 (hereafter referred to as AMS) and further in view of SiCommNet web pages captured via the WayBackMachine (archive.org) and hereafter referred to as SiComm.

Claims 4, 8 and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of SiComm, AMS and NIC I and II as applied to claims 1, 6 and 13 above, and

further in view of "Auctions Pay Dividends for Gov't"; L.S. Tillett, News release, May 2000, [www.internetwk.com](http://www.internetwk.com), 4 pgs (hereafter referred to as Auctions).

Applicant respectfully traverses this rejection as applied to the claims currently under consideration.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP 2143)

Claim 1 defines a "*computer related method for funding a state government procurement system*" including "*sending a second portion of the payment funds to a reserve fund*" and "*sending a provider payment from the reserve fund to the services provider*." On page 8 of the Office Action, the Examiner cites SiComm for these limitations at page 3, paragraph 4. Applicant respectfully points out that the Examiner has misinterpreted the reference with respect to the limitations of claim 1. SiComm discloses a scenario where a business entity can pay a subscription fee under the PRODUCTIVITY SERVICE PLAN for "significant additional functions" (SiComm, page 2, paragraph 8). As disclosed, 20% of these subscription fees paid by businesses go into a "revenue sharing pool", which is distributed to public agencies that select the PREMIUM PLAN. (SiComm, page 3, paragraph 4) That is, funds in the "revenue sharing pool" come from the businesses and go to the public agencies. By contrast, the method defined by claim 1 includes "*determining payment funds from the state government agency*", "*sending a second portion of the payment funds to a reserve fund*" and "*sending a provider payment from the reserve fund to the services provider*." That is, as defined by claim 1, "*payment funds*" are "*from the state government agency*", and "*a provider payment*" is sent "*to the services provider*."

The above-identified characteristic features of the present invention, defined clearly in claim 1 of the present invention, are not disclosed or suggested by the cited references. Therefore, claim 1 would not have been obvious to one of ordinary skill in the art at the time the

invention was made. Because they depend directly or indirectly from claim 1 claims 3, 4, 6, and 21-23 are likewise allowable over the cited references. Furthermore, these claims recite limitations further from claim 1 and are independently patentable.

With respect to claim 6, the claimed invention includes additional limitations related to “*an excess-funding threshold*”, “*an insufficient funding threshold*”, and “*an insufficient funding revision*.<sup>1</sup>” The Examiner has not described the disclosure or suggestion of these limitations in the cited references but indicates that these limitations “are given little patentable weight because the claim language is considered to be non-functional descriptive material.” (Office Action, page 11)

“The Examiner bears the initial burden of factually supporting any *prime facie* conclusion of obviousness. If the examiner does not produce a *prime facie case*, the applicant is under no obligation to submit evidence of nonobviousness.” (MPEP 2142) As noted above, a *prime facie* case of obviousness requires that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (MPEP 2143) In this case, the Examiner has not shown these limitations in the cited references, and therefore any consideration of “patentable weight” is inappropriate. Furthermore, the Examiner characterizes these limitations as “non-functional descriptive material” in spite of their relation to process steps as illustrated by the embodiment shown in Figure 5 (e.g., blocks 535 and 537). Therefore claim 6 is independently patentable.

For the reasons presented above in support of claim 6, claims 22-23 are also independently patentable.

Claim 9 defines a “*system for providing Internet-based electronic procurement services to a state government agency*” including “*executable commands for*” “*sending a second portion of the payment funds to a reserve fund*” and “*sending a provider payment from the reserve fund to the services provider*.<sup>1</sup>” For the reasons presented above in support of claim 1, claim 9 is allowable. Because they depend directly or indirectly from claim 9 claims 24-26 are likewise allowable over the cited references. Furthermore, these claims recite limitations further from

claim 9 and are independently patentable. For the reasons presented above in support of claim 6, claims 24-26 are independently patentable.

Claim 10 defines a “*system for implementing a computerized eProcurement system for a state government agency*” including “*executable instructions for*” “*sending a second portion of the payment funds to a reserve fund*” and “*sending a provider payment from the reserve fund to a services provider of the eProcurement system.*” For the reasons presented above in support of claim 1, claim 10 is allowable. Because they depend directly or indirectly from claim 10, claims 11, and 27-29 are likewise allowable over the cited references. Furthermore, these claims recite limitations further from claim 10 and are independently patentable. For the reasons presented above in support of claim 6, claims 27-29 are independently patentable.

Applicant submits that the claims as amended are distinguishable over the cited references and all references of record.

Applicant respectfully requests that the above-cited rejection under 35 U.S.C. § 103 be withdrawn.

#### Information Disclosure Statement

On December 14, 2000, an Information Disclosure Statement (IDS) was filed together with form PTO-1449 and six references. Applicant respectfully requests a return copy of the form PTO-1449 with initials to show that these references have been considered.

## CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and a Notice to that effect is earnestly solicited. If it is determined that a telephone conference would be helpful in advancing this case to an allowance, the Examiner is invited to contact the undersigned by telephone.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 426882000400. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

By:



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